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PATENT

Customer No. 22,852

Attorney Docket No. 05725.047001

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Jean-Michel STURLA

Serial No.: 09/385,412

Filed: August 30, 1999

For: AEROSOL DEVICE CONTAINING
A POLYCONDENSATE
COMPRISING AT LEAST ONE
POLYURETHANE AND/OR
POLYUREA UNIT

) Group Art Unit: 1616

) Examiner: M. Lamm

P. TUCK
#24
11/9/02

Commissioner for Patents and Trademarks
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION REQUIREMENT

In an election of species requirement dated September 10, 2002, the Examiner required election under 35 U.S.C. § 121 between the alleged species encompassed by alleged generic claim 1. The alleged species comprise:

- (a) polyurethanes and polyureas of claim 10; and
- (b) polysiloxane segment-containing polyurethanes and polyureas of claims 7-9 and 13.

Applicants provisionally elect the polyurethanes and polyureas of claim 10, with traverse.

Applicants traverse on the grounds that, to the extent the claims disclose and claim more than one species, the claims as written do not define an unreasonable

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number of species. The Examiner has identified that there are two allegedly distinct species defined by the claims. See Office Action at page 1. Applicants respectfully contend that two is not an unreasonable number of species, and therefore this election requirement should be withdrawn. See 37 C.F.R. § 1.141 and MPEP § 806.04(a).

Furthermore, Applicants note that the present application has undergone lengthy examination. Generic claim 1 was the subject of an Office Action, Final Office Action, and Advisory Action. The remaining claims were added in the Continued Prosecution Application of July 9, 2001, and have also been the subject of an Office Action. While Examiner Lamm has only recently taken over examination of this application, based on the prior Examiner's actions, the Office has heretofore determined that no burden exists which requires the examination of separate species.

Since a search has already been undertaken for the entire scope of the application, Applicants submit that the Office has admitted that no burden exists which rises to the level of "serious." If the Examiner wishes to maintain this election requirement, she is respectfully requested to set forth with specificity what new or added burden now exists that did not already exist during the previous four Actions on the merits. See MPEP § 810.01 (when action on the merits occurs before a restriction, "a question may arise as to whether there is a serious burden on the Examiner").

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

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Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: November 4, 2002

By: 

Lori-Ann Johnson
Reg. No. 34,498

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